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09/751,669	12/29/2000	David D. Koester	S01.12-0697	8902

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EXAMINER

CHEN, TIANJIE

ART UNIT PAPER NUMBER

2627

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/751,669  
Filing Date: December 29, 2000  
Appellant(s): KOESTER ET AL.

**MAILED**

**MAY 31 2006**

**Technology Center 2600**

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David D. Brush  
For Appellant

**EXAMINER'S ANSWER**

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This is in response to the appeal brief filed 01/23/2006 appealing from the Office action mailed 10/19/2005

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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**(6) Grounds of Rejection to be Reviewed on Appeal**

Since multiple 35 USC § 102 rejections were made in the Office action. Examiner only elects two 102 rejections for review; they are:

1. Rejection of claim 13 under 35 U.S.C. 5 102(e) based on Williams et al. U.S. Patent No. 6,538,853 and product-by-process rejection.

2. Rejection of claim 13 under 35 U.S.C. 5 102(b) based on Born et al. U.S. Patent No. 5,930,581.

3. Rejection of claims 17-18 under 35 U.S.C. 5 103(a) based on Williams et al./Born et al. in view of Brar et al. U.S. Patent 5,156,919.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix submitted separately in 03/20/2006 is correct.

**(8) Evidence Relied Upon**

6,538,853	Williams et al	3-2003
5,930,581	Born et al	7-1999
5,156,919	Brar et al	10-1992

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

*Claim Rejections - 35 USC § 102*

1. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Williams et al (US 6,538,853).

With regard to claim 13, Williams et al shows an actuator in Fig. 1B, with external peripheral surface extending along an entire periphery of the actuator and including a desired profile dimension entirely defined by the external peripheral surface.

Williams does not show the method used for forming the peripheral surface. However, "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (MPEP § 2113 [R-1]).

2. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Born et al (US 5,930,581).

With regard to claim 13, Born et al shows an actuator in Fig.1, wherein the actuator arm is machined from 2.5 by 5.25 cm tape, which has machined external peripheral surface extending along an entire periphery of the actuator and including a desired profile dimension entirely defined by the machined external peripheral surface (Column 9, lines 33-54).

Although Wood et al shows it is machined, as shown above, in a product-by-process claim, the process related limitation, in this claim is limitation "machined" still does not earn weight in determining patentability.

*Claim Rejections - 35 USC § 103*

3. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al/Wood et al/Born et al/ Hyde in view of Brar et al (US 5,156,919).

Williams et al/Wood et al/Born et al/ Hyde et al shows an actuator as described above, wherein the external peripheral surface is machined, but Williams et al/Wood et al/Born et al/ Hyde is silent on the tolerance of the dimension of the surface.

Bar et al shows an actuator with a carriage, which is machined to a tolerance of about 0.003 inches (Column 5, lines 59-60).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to set the tolerance to 0.003 inches as taught by Brar et al. the rationale is as follows: in machining, a tolerance is inherent, but Williams et al/Wood et al/Born et al/ Hyde does not specify it. One of ordinary skill, in the art would have been searching for the tolerance. Brar et al shows a carriage of an actuator having a tolerance of 0.003 inches, which is less than 0.005 inches. And it is well known in the art that this tolerance is commonly achievable at the time the invention was made. One of ordinary skill in the art would have been motivated to set the tolerance in Wood et al's device to 0.003 inches as taught by Brar et al. In such constructed device, the tolerance is less than 0.005 inches.

**(10) Response to Argument**

**Argument I. A:**

- Applicant argues that the machined surface has different appearance comparing with a cast or extruded surface.

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- Examiner's position: "machined" is a process of making the surface. As MPEP states: "If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). (MPEP 2113 [R-1], first section). In instant case, Both Applicant's product and Prior Art's product are: an external peripheral surface extending along an entire periphery of the actuator and comprising a desired profile dimension entirely defined by the external peripheral surface. It reads on the claim MPEP further states: "when the prior art disclose a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section of 102 or 103 of the status is eminently fair and acceptable." (MPEP 2113 [R-1], section 3). In instant case, Applicant emphasized difference, i.e. the difference between the micro grooves generated by machining and dull smooth surface generated by cast or extruding plays no role in meeting the claimed feature of "comprising desired profile dimension" since all actuators used in the art must be manufactured to have a "desired profile dimension." Therefore, the difference between micro-grooves and dull, smooth surface should be considered as "slightly different" and the rejection is eminently fair and acceptable.

**Argument I.B:**

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- Examiner does not use “machining” from Williams’s prior art in rejection. Applicant’s argument is moot.

**Argument II.**

- As stated above, Examiner had made a multiple of 102 rejections in Office action. In the examiner’s answer, Examiner only uses two 102 rejections as recited above as below. Argument II is escaped.

**Argument III:**

- Examiner’s position: Born et al (US 5,930,581) discloses in Fig. 1 that the actuator consists of three portions: Aluminum Boron Carbide Voice Coil Yoke, Aluminum Body, and Aluminum Boron Carbide Actuator Arms. Born et al further shows that the Aluminum Boron Carbide Voice Coil Yoke is machined to 0.100 inch thick, 0.8 inch long, and 1.072 inch wide (Column 9, lines 28-32); the Aluminum Body is shaped via machining ( column 9, lines 62-65); and Aluminum boron carbide Actuator Arm is machined to an arm geometry with dimension of about 1.314 inch long and about 0.5 to 0.165 inch taper from back to front (Column 9, lines 46-51). It clearly shows that the entire surface of these three pieces are machined; the finale assembled actuator as shown in Fig. 1 should have entire surfaces, including the entire peripheral surface, are machined.

**Argument IV:**

- As stated above, Examiner had made a multiple of 102 rejections. In the examiner’s answer, Examiner only uses 2 rejections as recited above as below. This argument is escaped.



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**Argument V:**

- As discussed above, Applicant's above arguments are moot, Applicant's argument V is moot.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the examiner in the Related Appeals and Interferences section of this examiner's answer identifies the Board.

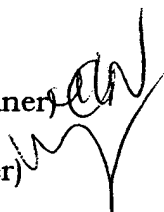
**For the above reasons, it is believed that the rejections should be sustained.**

Respectfully submitted,

  
**TIANJIE CHEN**  
**PRIMARY EXAMINER**

Conference held on 05/24/2006.

Conferees:

Hoa Thi Nguyen (Supervisory Patent Examiner) 

Wayne Young (Supervisory Patent Examiner)

Brain Miller (primary Patent Examiner) /Brian E. Miller/

Tianjie Chen (Primary Patent Examiner) 